

*Application No. 10/799,724
Reply dated May 22, 2009
Reply to Office Action of January 22, 2009*

*Docket No.3868-0156P
Art Unit: 1771
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REMARKS

The Applicants thank the Examiner for the thorough consideration given the present application. Claims 21-24, 26-33, and 36-45 are pending, of which claim 21 is amended, and claims 41-45 are added. Claims 1-20, 25, 34, and 35 were previously cancelled without prejudice to or disclaimer of the subject matter set forth therein. Claims 36 and 37 are withdrawn. Claim 21 is independent. The Examiner is respectfully requested to reconsider the rejections in view of the amendments and remarks set forth herein.

Examiner Interview

If, during further examination of the present application, a discussion with the Applicants' Representative would advance the prosecution of the present application, the Examiner is encouraged to contact Carl T. Thomsen, Registration No. 50,786, at 1-703-208-4030 (direct line) at his convenience.

Rejection Under 35 U.S.C. § 112, second paragraph

Claims 21-24, 26-33, and 38-40 stand rejected under 35 U.S.C. § 112, second paragraph. This rejection is respectfully traversed.

The Examiner has set forth certain instances wherein the language of claim 21 is not clearly understood.

In order to overcome this rejection, the Applicants have amended claim 21 to correct the deficiencies specifically pointed out by the Examiner. The Applicants respectfully submit that the claims, as amended, particularly point out and distinctly claim the subject matter which

the Applicants regard as the invention. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Rejections Under 35 U.S.C. §103(a)

Claims 21, 23, 28, 30, 32, 33, and 38-40 stand rejected under 35 U.S.C. §102(b) as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as being unpatentable over Wambeke et al. (U.S. 5,741,014) in view of Bonk et al. (U.S. 4,731, 273) and Czepel et al. (U.S. 4,277,532);

claim 22 stands rejected under 35 U.S.C. §102(b) under 35 U.S.C. §103(a) as being unpatentable over Wambeke et al. in view of Bonk et al. and Czepel et al., and further in view of Woods (U.S. 4,414,275);

claim 24 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Wambeke et al. (U.S. 5,741,014) in view of Bonk et al., and further in view of Stanek (U.S. 3,959,052);

claim 26 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Wambeke et al. (U.S. 5,741,014) in view of Bonk et al., and further in view of Flint (Re. 30,843);

claim 27 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Wambeke et al. (U.S. 5,741,014) in view of Bonk et al., and further in view of Komiyama et al. (U.S. 5,118,567); and

claim 29 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Wambeke et al. (U.S. 5,741,014) in view of Bonk et al., and further in view of Lautenschlaeger et al. (U.S. 4,814,215).

These rejections are respectfully traversed.

Amendments to Independent Claim 21

While not conceding the appropriateness of the Examiner's rejection, but merely to advance the prosecution of the present application, independent claim 21 has been amended herein to recite a combination of elements directed to a pressure-sensitive adhesive material or a sealing material which has a three-dimensional structure and a defined cross-sectional contour, including *inter alia*

"wherein said material is present in a form of strings, strands or strips, wherein said strings, strands or strips have a round, semicircular, oval, elliptical, triangular, quadrangular, V-shaped, polygonal or irregular cross-sectional contour and a surface that is bent, curved or provided with edges corresponding to said cross-sectional contour."

Regarding Wambeke et al.

According to the Examiner, Wambeke et al. disclose a sealing material formed of pressure-sensitive adhesive and having a cross-sectional contour which deviates from a flat two-dimensional geometry, being semi-circular, triangular, quadrangular, etc., as shown in Figs. 4, 5 and 6 and described in col. 8.

The Examiner has further indicated (in item 12.) that the term "strip" would be interpreted as referring to "a long narrow piece of material" which definition would also read on the sealing material disclosed by Wambeke.

First, the Applicants submit that Wambeke et al. do not unambiguously teach that the “discrete portions of sealing material 17” shown in Figs. 4 and 5 are made from pressure-sensitive adhesive. As stated in col. 8, lines 42-44, these portions are made of “sealing material, e.g. mastic.” Although “pressure-sensitive adhesive” is mentioned as “another preferred sealing material” in col. 5, lines 34-36, there is no teaching as to how such an adhesive could be formed into the specific shapes shown in Figs. 4 and 5. On the other hand, Wambeke et al. describe particular types of mastic which, due to their mechanical properties, are suitable for Wambeke et al.’s invention (col. 4, line 61, to col. 5, line 21). Due to these known properties, and the availability of these materials (mastic, gels), these sealing materials could have been expected to be suitable for forming the “discrete portions of sealing material 17” shown in Figs. 4 and 5.

In contrast, Wambeke et al. fail to indicate the types of pressure sensitive adhesives which, due to their mechanical properties (e.g. hardness, creep properties, compression set, needle penetration), might be suitable for forming said “discrete portions.”

Therefore, upon reading the description of Wambeke et al.’s invention, the skilled person would have concluded that the mastic or gels would be suitable for making the “discrete portions,” rather than considering the use of “pressure sensitive adhesives” since Wambeke et al. fail to provide any guidance for selecting suitable adhesives.

It also appears questionable whether Wambeke et al.’s teaching can be regarded as being “enabling” as regards to the use of pressure sensitive adhesives as said sealing material, in view of the fact that no hints whatsoever are provided as regards the selection of suitable pressure

sensitive adhesives, and further in view of the fact that the prior art (e.g. the additional prior art documents cited in the present Office Action) could not have provided such guidance either.

Regarding Bonk et al.

Bonk et al. teach adhesive layers which are flat, rather than being shaped with a cross sectional contour as defined in the instant claims. Also, Bonk et al. fail to teach how the pressure-sensitive adhesive described therein could be converted into a “discrete portion of sealing material 17” as would be required by Wambeke et al. Likewise, Czepel et al. merely disclose an adhesive *coating* in the form of a sheet material which is regarded as being essentially 2-dimensional, considering that the thickness of this sheet material is extremely small (1.9 mm; col. 4, line 12) as compared to its area (100 cm wide, length: at least 2 m; col. 3, lines 51 and 60).

Similarly, Woods teaches flexible adhesive tapes provided with an adhesive *coating* which does not have a “defined cross-sectional contour” as defined in the present claims. The same applies to Stanek (“applying a *layer* of alkyl cyanoacrylate adhesive”; col. 2, lines 21-22, col. 4, lines 35-36).

Regarding Bonk et al., Czepel et al., Woods, Flint, Komiyama et al., and Lautenschlager et al.

Bonk et al., Czepel et al., Woods, Stanek, Flint, Komiyama et al. and Lautenschlager et al. were merely cited for teaching additional features recited in the dependent claims. These documents are silent in regards to the formation of materials having a defined cross-sectional contour as presently claimed.

Also, these documents do not contain any teaching that would have enabled the skilled person to form “discrete portions” mentioned by Wambeke et al., by using pressure sensitive adhesive as sealing material. Since neither Wambeke et al., nor any of the other prior art documents, teaches how the “discrete portions” could be made from pressure sensitive adhesive, Wambeke et al.’s Figs. 4-6 cannot be interpreted as disclosing materials having a defined contour as required in present claim 21 and being produced from a polymerizable mass as defined in this claim.

With respect to present claim 38 which requires the material to be present as rolled or continuous material, the Examiner has alleged (item 18) that it would have been obvious to present the sealing material of Wambeke et al. in the form of rolled or continuous material, motivated by the desire to suitably package the sealing material. Applicants strongly disagree with this view, since Wambeke et al. teach that the portions of sealing material 17 shown in Wambeke et al.’s Figs. 4-6 are formed by winding strips of sealing material around the wire of the frame (col. 8, lines 59-62). In this connection, it is important to note that the “strips of sealing material” do not have a cross-sectional contour as defined in present claim 21. According to Wambeke et al., and as interpreted by the Examiner, the three-dimensional contour is only obtained when strips of sealing material are wound around the wire of the frame. The resulting “portions of sealing material 17,” however, are never present in the form rolled or continuous material. Also, when contemplating the embodiments shown in Wambeke et al.’s drawings, it is difficult to envision how these portions of sealing material could be present as a rolled material. While it may be regarded as trivial to produce adhesive tapes or sheets in the form of rolled or

continuous material, the same does not apply to materials having a defined cross-sectional contour as presently claimed. Generally, the three-dimensional (non-flat) shape of the claimed material implies that it would be difficult to manufacture this material in the form of rolls or coils. Therefore, the preferred embodiment of claim 38 cannot be regarded as being obvious to the skilled person.

At least for the reasons described above, the Applicants respectfully submit that the combination of elements as set forth in independent claim 21 is not disclosed or made obvious by the prior art of record, including Wambeke et al., Bonk et al., and Czepel et al.

Accordingly, reconsideration and withdrawal of these rejections are respectfully requested.

Independent claim 21 is in condition for allowance.

Dependent Claims

With respect to new claims 42-45, it is submitted that it was not obvious to the skilled person to provide a material having a defined cross-section as specified in claim 21 and being produced as defined in claim 42 or 43. As explained above, Wambeke et al. fail to teach how the “portions of sealing material” could be made from pressure sensitive adhesives. In particular, Wambeke et al. do not disclose or suggest that said defined cross-section could be imparted on the material by applying the methods referred to in claims 42 and 43.

All dependent claims are in condition for allowance due to their dependency from allowable independent claims, as well as for the additional novel limitations set forth therein.

All claims of the present application are now in condition for allowance.

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CONCLUSION

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. It is believed that a full and complete response has been made to the outstanding Office Action, and that the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, he is invited to telephone Carl T. Thomsen (Reg. No. 50,786) at (703) 208-4030 (direct line).

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly extension of time fees.

Respectfully submitted,

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